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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/805,184 | 03/14/2001 | Kenji Ohshima | Q63509 | 2848 |

7590 08/26/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202

EXAMINER

BRUENJES, CHRISTOPHER P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1772

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/805,184

Applicant(s)

OHSHIMA ET AL.

Examiner

Christopher P Bruenjes

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6.

Claim(s) withdrawn from consideration: 7-20.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9.
10. ☐ Other: _____

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claim 1 in Paper #10 have not been entered due to the fact that they raise new issues that would require further consideration and/or search. The limitation "configure to provide" information "to identify" the type of said sheet roll, raises new issues because further consideration is required to determine if each of the two primary references still anticipate that is "configured to provide". The original claim only required that the target "is detectable", which only required that the target could be detected for providing information, while the amended claim requires that the target has a certain configuration that enables information to identify the type of sheet roll. Although the claim was objected to the way in which the claim was amended to overcome that objection changed the scope of the claim in regards to the prior art. The suggested change provided in the last office action would not have changed the scope of the claim in regards to the prior art.

ANSWERS TO APPLICANT'S ARGUMENTS

2. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 102 rejections of claims 1, 2, 4, and 5 as anticipated by

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Nedstedt of record have not been considered because the arguments are based on the amendment provided in Paper #10 that has not been entered.

3. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 102 rejections of claims 1, 2, 4, and 5 as anticipated by Lammers of record have not been considered because the arguments are based on the amendment provided in Paper #10 that has not been entered.

4. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 103 rejections of claims 1-6 over Nedstedt in view of Adams of record are not persuasive.

In response to Applicant's argument that there is not suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. See *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the

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art. See In re Laughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art rather than by their specific disclosures. See In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, Adams teaches that inserts or targets are configured and are inserted in rolls in order to provide information to identify the type of roll. Adams specifically teaches identifying the type of roll regarding the color of yarn found on that roll. Furthermore, one of ordinary skill in the art would have recognized that similar identification means are used to distinguish different types of sheet rolls as different types of yarn rolls, because rolls of yarn and rolls of sheets are structurally similar and both rolls are used as starting materials and are unrolled from said roll in order to make new products. Note "type of roll" defined in its broadest sense defines only that the rolls are different and that there is something to distinguish the difference. For Adams the "type of roll" is referring to color of the yarn on the roll, for Nedstedt "type of roll" is referring to a full roll or empty roll.

In response to applicant's argument that neither Nedstedt nor Adams teaches the target is located at one of a plurality of predetermined positions. The rolls of both Nedstedt and Adams have a plurality of predetermined positions by the pure fact

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that they are three-dimensional objects. The objects have to have a center position, end position, an in between position, outside position, inside position, etc. In the case of Nedstedt the predetermined position chosen for the target is the center position. In the case of Adams the predetermined position chosen for the target is the end position. One of ordinary skill in the art would have recognized that a three-dimensional object such as a roll or tube must have predetermined positions and that if the target is in the roll it must be located in one of a plurality of predetermined positions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


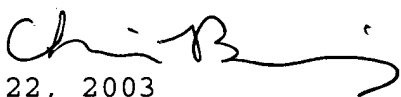
Christopher P Bruenjes

Examiner

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CPB

August 22, 2003



HAROLD PYUN
SUPERVISORY PATENT EXAMINER
1772

8/22/03